REMARKS/ARGUMENTS

Claims 1-32 are pending in the present application.

Applicant respectfully requests that the Examiner withdraw the rejections of the pending claims.

Claims 1-32 were rejected under 35 USC § 103(a) as being unpatentable over Chene in view of Carr. Section 103(a) reads in part, "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title...", which has long been held to imply that any cited combination of references much teach and/or disclose each and every limitation of the claimed invention. According to MPEP 2143, exemplary rationales that may support a conclusion of obviousness include "(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." (Emphasis added). Therefore, in order to show a prima facie case of obviousness using this rationale, the Patent Office must show that the cited combination teaches each and every limitation in the claim. In the present case, the Applicant respectfully submits that the cited combination of Chene and Carr fails to disclose at least the limitation of "calculating the benefit of implementing the business improvement by comparing the actual performance information to estimated performance information determined prior to an introduction of the business improvement." As such, the Patent Office has failed to demonstrate a prima facie case of obviousness, and claims 1-32 should be in condition for allowance.

In a previous submission, the Applicant argued that the independent claims recite in part comparing the actual measured information with predicted performance information—a feature that is clearly not present in either of Chene or Carr. The Patent Office responded that this argument was unpersuasive as the originally filed disclosure did not support this assertion, citing paragraph [0012] of the specification as originally filed. However, the Patent Office then cited paragraph [0012], and emphasized the following passage:

> Generally, the benefits are measured by comparing actual performance information of a business after a business improvement has been introduced, to estimated performance information prior to introduction of the business improvement.

The Patent Office then remarked that, "it is clear that actual performance is the performance after the improvement while the estimated performance is the performance before the improvement." This much is not in dispute, but it must necessarily follow from the paragraph [0012] and the Patent Office's own admission that the noted limitation involves a comparison between actual performance information and estimated/predicted performance information, wherein the estimated/predicted performance information is estimated/predicted prior to introduction of the business improvement. That the noted limitation is supported by the specification should be clear at this point.

The Patent Office further stated that Carr teaches the aforementioned limitation at Col. 32, lines 53-67. As previously noted by Applicant, Carr states "preparing information on the ROI and savings from performing any recommended actions." Carr at column 32, lines 37-39. Further, at column 32, lines 61-63 Carr specifically recites "list[ing] of the recommended actions to be performed and an estimate of the ROI by taking the actions." Both of the above statements talk about looking at a baseline energy usage, making a recommendation, and calculating the savings based on the energy company making the recommended changes. Carr does discuss changing the model, at column 16, lines 33-43 by creating a baseline, then changing the operational model after each tune up to get a different outcome and new baseline. However, it does not discuss or imply, using actual measured information over a period of time nor comparing the same to estimated performance information, as recited in the independent claims of the present application.

The Patent Office has stated that Carr does in fact teach using actual measured data over a period of time, citing Carr at Col. 33, line 4 and Col. 35, lines 42-45. However, a careful reading of the cited passages reveals that Carr, in fact, teaches a spreadsheet that includes a detailed description of the data used to create the baseline model of the facility, which clearly fails to disclose the usage of actual performance information/data as recited in the independent claims. See Carr at Col. 33, lines 1-7. With respect to Carr dependent claim 17, also cited by the

Patent Office, it is noted that the cited claim specifically recites providing a customer report to a customer, which again, is largely irrelevant to the specific limitations recited in the independent claims.

As above, there is nothing in either of the references that specifically and identically teaches the cited limitation. Applicant respectfully notes that while it is possible for references to suggest or motivate their own combination for purposes of section 103, it is improper to argue that a reference itself can suggest or motivate a specific limitation in a claim. In order for the Patent Office to maintain the current rejection, it must be able to demonstrate a prima facie case of obviousness, which is not the case in the present application. Accordingly, the Applicant respectfully requests that the Patent Office withdraw the pending rejection and permit the all of the pending claims to proceed to allowance.

Applicant also respectfully renews its objection based on the proposed use and combination of Chene and Carr, as neither reference is analogous art. While the Patent Office has cited a case in favor of the proposition that Chene is analogous art, no argument has been made as to why one of skill in the art would combine Chene with Carr. The latter deals exclusively with the energy consumption of buildings and permanent structures and not vehicular maintenance, which is the field of endeavor specified for Chene by the Patent Office.

In conclusion, Applicant respectfully submits that the pending claims 1-32 are not obvious over the cited art, and further that the cited art is non-analogous to the present invention and therefore their proposed combination is improper. Allowance of claims 1-32 is respectfully requested.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below. Applicant does not believe any fees are due regarding this amendment. If any fees are required, however, please charge Deposit Account No. 17-0026. Applicant encourages the Examiner to telephone the Applicant's attorney should any issues remain.

Respectfully submitted,

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